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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,932	01/26/2004	John M. MacLaren	200301725-4	9646
7590	01/13/2005			EXAMINER
HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400			DUVERNE, JEAN F	
			ART UNIT	PAPER NUMBER
			2839	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/764,932	MACLAREN ET AL.
	Examiner	Art Unit
	Jean F. Duverne	2839

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 18 October 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-29 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-29 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_

4)  Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

**DETAILED ACTION**

In view of applicant's argument, the examiner has changed the double rejection to an obvious double patenting because of the minor differences in the claims.

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-29 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No.

US006692293B2 . Although the conflicting claims are not identical, they are not patentably distinct from each other because most of the limitations of the current application are included in the patent (see below).

1. MacLauren's (US006692293) device discloses a first substrate configured to provide location identification signals or identifiers (see lines 1-3 of claims 1) to a plurality of locations on the first substrate; a plurality of connectors coupled to the first substrate at the plurality of locations, each connector comprising an identification device uniquely configured to provide substrate location information and to receive the corresponding location identification signals; and a plurality of second substrates, each second substrate coupled to a corresponding connector such that the unique identification device couples the corresponding location identification signals or identifier (see abstract) to the second substrate (see claims 1, 12, 18); wherein the first substrate is configured to receive five connectors (see claims 2, 13); wherein each connector comprises a memory cartridge connector (see claims 3, 14, 19); wherein the first substrate is configured to receive an array of connectors arranged in a plurality of rows and columns (see claims 4, 14); wherein each connector comprises a memory cartridge connector (see claims 5, 16); wherein each identification device comprises a plurality of contacts uniquely configured to be coupled to one of a logical high signal and a logical low signal (see claims 6, 17, 20); wherein the uniquely configured identification device represents a physical location of the corresponding connector with respect to the first substrate (see claims 7, 21); wherein the uniquely configured identification device represents an electrical

location of the corresponding connector with respect to the first substrate (claims 8, 22); wherein each of the plurality of second substrates comprises a plurality of memory modules; wherein each of the plurality of memory modules comprises a plurality of memory devices (claim 9); wherein each of the plurality of second substrates comprises a memory controller (claim 11); (b) coupling a plurality of connectors to the first substrate, the connectors each comprising a plurality of contacts and traces arranged in a unique configuration with respect to the others of the plurality of connectors, wherein the unique contact and trace configuration provides location information; (c) electrically coupling each of the plurality of contacts to the first substrate; (d) providing a logical signal to each of the plurality of contacts, the logical signals providing a unique identifier for each of the plurality of connectors, wherein the unique identifier corresponds to a unique location of one of the plurality of connectors; (e) coupling a plurality of second substrates to the plurality of connectors; (f) electrically coupling the plurality of second substrates to the plurality of contacts; (g) latching the plurality of logical signals of the plurality of contacts to a plurality of control devices existing on the plurality of second substrates (see claims 23). It is inherent for the substrate to have traces. The use of substrate or trace does not clearly patentability any patentability weight. Providing or receiving information is a functionality limitation which does add any patentability weight.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean F. Duverne whose telephone number is

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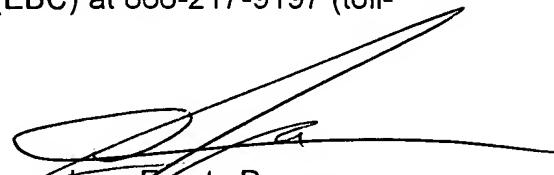
(571) 272-2091. The examiner can normally be reached on 9:00-7:30, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TC Patel can be reached on (571) 272-2098. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JFD

01082005



Jean Frantz Duverne  
Primary Examiner  
Art Unit 2839